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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,104	12/03/2001	Fukuharu Sudo	7217/47270-Z-RE/JHM/KJB	3624

7590 07/22/2003
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New York, NY 10036

EXAMINER

VO, NGUYEN THANH

ART UNIT	PAPER NUMBER
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2685

DATE MAILED: 07/22/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,104

Applicant(s)

SUDO ET AL.

Examiner

Nguyen T Vo

Art Unit

2685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28-April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7-8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. **The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.**

Information Disclosure Statement

2. The information disclosure statements filed 02/27/2003, 04/28/2003 have been considered.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahlberg (5,758,295) in view of Mailey (5,237,311).

Regarding claim 5, Ahlberg discloses a portable communication terminal apparatus comprising a body (see figure 2A); transmitting and receiving means (see the transceiver 124 in figure 2B); selecting operation means (see the keys 112 and 114); operation detection means (see column 9 line 49 to column 10 line 17); storage means 122 (see also column 10 lines 40-46, column 11 lines 56-67, figures 6A-9B); display means 110, and control means 120 (see figure 2B). Ahlberg, however, fails to disclose that the selection operation means is operable by a user in a first direction along a surface of the body and in a second direction substantially perpendicular to the first direction, and that the display layout when the selection operation means is operated in the first direction is recognizably different from the display layout when the selection operation means is operated in the second first direction. Mailey discloses a selection operation means such as a rotatable jog dial selection device 10 which is operable by a user in a first direction along a surface of a body (in this case, the first direction as claimed reads on the rotation direction as disclosed at column 1 lines 55-59), and in a second direction substantially perpendicular to the first direction (in this case, the second direction as claimed reads on the downward direction as disclosed at see column 5 lines 25-30). In Mailey, the first direction is circumferential relative to the jog dial and the second direction is radial relative to the jog dial (see figure 2). Mailey further discloses that the display layout when the selection operation means is operated in the first direction (see column 1 lines 26-31 which discloses that a cursor or pointer is

moved on a display in response to the first direction) is recognizably different from the display layout when the selection operation means is operated in the second first direction (see column 1 lines 25-31 which discloses that a selected menu is displayed in response to the second direction). See also column 1 lines 52-59, column 2 line 41 to column 3 line 50. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the above teaching of Mailey to Ahlberg, in order to obtain an integration of a trackball and a selection device, eliminate the awkward repositioning of fingers for engaging a separate pushbutton or other selection device, and also reduce the cost (as suggested by Mailey at column 2 lines 3-13).

As to claim 6, the combination of Ahlberg and Mailey discloses the claimed limitations (see column 1 lines 26-32 and lines 55-59 in Mailey).

Allowable Subject Matter

6. Claims 1-4 are allowed.

As to claims 1-4, the prior art fail to disclose or render obvious the claimed invention for the reasons as set forth in the parent application 08/932,942.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Will (5,477,508) discloses control of digital watch using menu and thumbwheel (see figures 1 and 2).

Response to Arguments

8. Applicant's arguments with respect to claims 5 and 6 have been considered but are moot in view of the new ground(s) of rejection.

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nguyen T Vo whose telephone number is (703) 308-6728. The examiner can normally be reached on Monday-Friday and alternate Monday from 8:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Urban can be reached on (703)305-4385. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for all communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

A handwritten signature in black ink, appearing to read "Nguyen T. Vo". The signature is fluid and cursive, with a prominent "V" at the end.

NGUYEN T. VO
PRIMARY EXAMINER

Nguyen Vo

July 17, 2003